UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,572	12/05/2000	Daniel Schreiber	43426-00049	6837

30256	7590	04/05/2005

SQUIRE, SANDERS & DEMPSEY L.L.P
600 HANSEN WAY
PALO ALTO, CA 94304-1043

EXAMINER
BACKER, FIRMIN

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 March 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-86</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-86</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on March 7th, 20005 has been entered.

Response to Arguments

2.   Applicant's arguments with respect to claims 1-86 have been considered but are moot in

view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claims 1-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guedalia

(U.S. Patent No. 6,121,970) in view of Aldred et al (U.S. Patent No. 6,209,036) in further view

of Marmor (U.S. PG Pub No. 2002/0026475).

5.   As per claims 1, 23, Guedalia teaches a method for protecting digital images distributed

over a network, comprising the steps of: receiving a request from a client computer running a

network browser, for an original layout page containing references to digital images therein;

parsing the original layout page for the references to digital images, generating a modified layout

page from the original layout page by replacing at least one of the references to digital images in

the original layout page with references. (*see column abstract, column 1 lines 19-30, 3 line 65-4*

lines 41, 6 lines 4-36, claim 1). Guedalia fails to teach an inventive concept of substitute data file

prior to responding to the client computer request and sending the modified layout page to the

client computer in response to the client computer request. However Aldred et al teach an

inventive concept of substitute data file prior to responding to the client computer request and

sending the modified layout page to the client computer in response to the client computer

request (*see column 4 lines 66-5 lines 25)*. Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify the inventive concept of

Guedalia to include Aldred's inventive concept of substitute data file prior to responding to the

client computer request and sending the modified layout page to the client computer in response

to the client computer request because this would have improved management of and access to

information, images and other material via the World Wide Web Internet service. The

combination of Guedalia and Alfred et al fail to teach an inventive concept of digital images that

are designated as being protected. However, Marmor teach inventive concept of digital images

that are designated as being protected (*see paragraph 0098)*. Therefore, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify the

combined inventive concept of Guedalia and Alfred to include Marmor's inventive concept of

digital images that are designated as being protected because this would have enhance the

security of the system.

6. As per claims 2-4, 24-26, Guedalia teaches a method wherein the layout page is a hyper-

text markup language (HTML, XML, ASP) page *(see column 12 lime 15-58)*.

7. As per claims 5 and 27, Guedalia teaches a method of determining characteristics of the

network browser used by the client computer to issue the request *(see column 12 lime 15-58)*.

8. As per claims 6 and 28, Guedalia teaches a method wherein the substitute data referenced

in the modified layout page depends on the characteristics of the network browser used by the

client computer *(see column 12 lime 15-58)*.

9. As per claims 7 and 29, Guedalia teaches a method of locating tags within the layout

page indicating references to digital images; and identifying protection status of the digital

images, based on information in a protection status database *(see column 15 lines 11-63)*.

10. As per claims 8 and 30, Guedalia teaches a method of locating tags within the layout

page delimiting protected parts of the layout page; extracting references to digital images within

the protected parts of the layout page; and identifying protection status of the digital images,

based on information in a protection status database *(see column 15 lines 11-63)*.

11.   As per claims 9-11, 31-33, Guedalia teaches a method wherein the substitute data is pre-

defined text/image data *(see column 12 lime 15-58)*.

12.   As per claims 12-14, 34-36, Guedalia teaches a method of deriving the substitute data

from the digital images, is watermarked data derived from the digital images, is encrypted data

derived from the digital images using an encryption algorithm *(see column abstract, column 1*

lines 19-30, 3 line 65-4 lines 41, 6 lines 4-36, claim 1).

13.   As per claims 15, 37, Guedalia teaches a method wherein at least one of the references to

digital images is a reference to an alias for a protected digital image *(see column abstract,*

column 1 lines 19-30, 3 line 65-4 lines 41, 6 lines 4-36, claim 1).

14.   As per claims 16-18, 38-40, Guedalia teaches a method of looking up a file name/address

for the protected digital image, corresponding to the alias for the protected digital image resides

on a remote computer *(see column 15 lines 11-63)*.

15.   As per claims 19, 41, Guedalia teaches a method of requesting protected digital image

data from the remote computer, using the address for the remote computer and the file name for

the protected digital image; and receiving protected digital image data from the remote computer

(see column 15 lines 11-63).

16.   As per claims 20-22, 42-44, Guedalia teaches a method of deriving the substitute data

from the protected digital image data, is watermarked data derived from the protected digital

image data, is encrypted data derived from the protected digital image data using an encryption

algorithm (*see column abstract, column 1 lines 19-30, 3 line 65-4 lines 41, 6 lines 4-36, claim 1*).

17.   As per claims 45 and 66, Guedalia teaches a method/system for protecting digital images

distributed over a network, comprising the steps of: receiving a request from a client computer;

submitting the request to a server computer; receiving an original layout page containing

references to digital images therein from the server computer; parsing the original layout page

for the references to digital images; generating a modified layout page from the original layout

page by replacing at least one of the references to digital images in the original layout page with

references (*see column abstract, column 1 lines 19-30, 3 line 65-4 lines 41, 6 lines 4-36, claim

1*). Guedalia fails to teach an inventive concept of substitute data file prior to responding to the

client computer request and sending the modified layout page to the client computer in response

to the client computer request. However Aldred et al teach an inventive concept of substitute data

file prior to responding to the client computer request and sending the modified layout page to

the client computer in response to the client computer request (*see column 4 lines 66-5 lines 25*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the inventive concept of Guedalia to include Aldred's inventive concept of

substitute data file prior to responding to the client computer request and sending the modified

layout page to the client computer in response to the client computer request because this would

have improved management of and access to information, images and other material via the

World Wide Web Internet service. The combination of Guedalia and Alfred et al fail to teach an

inventive concept of digital images that are designated as being protected. However, Marmor

teach inventive concept of digital images that are designated as being protected (*see paragraph

0098*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the combined inventive concept of Guedalia and Alfred to include

Marmor's inventive concept of digital images that are designated as being protected because this

would have enhance the security of the system

18.   As per claims 46-51 and 67-72, Guedalia teaches a method/system of appending an

identifier to the request; authenticating the request based on the identifier; and removing the

identifier from the request, randomly generating the identifier, dynamically generating the

original HTML, XML or ASP layout page (*see column 12 lime 15-58*).

19.   As per claims 52 and 73, Guedalia teaches a method/system of locating tags within the

layout page indicating references to digital images; and identifying protection status of the digital

images, based on information in a protection status database (*see column 15 lines 11-63*).

20.   As per claims 53 and 74, Guedalia teaches a method/system of locating tags within the

layout page delimiting protected parts of the layout page; extracting references to digital images

within the protected parts of the layout page; and identifying protection status of the digital

images, based on information in a protection status database (*see column 15 lines 11-63*).

21.   As per claims 54-57 and 75-78, Guedalia teaches a method/system wherein the substitute

data is pre-defined image/watermarked data derived from the digital images and is encrypted

data derived from the digital images using an encryption algorithm (*see column 12 lime 15-58*).

22.   As per claims 58 and 79, Guedalia teaches a method/system wherein at least one of the

references to digital images is a reference to an alias for a protected digital image (*see column 12

lime 15-58*).

23.   As per claims 59-61 and 80-82, Guedalia teaches a method/system of looking up a file

name/address for the protected digital image, corresponding to the alias for the protected digital

image resides on a remote computer (*see column 12 lime 15-58*).

24.   As per claims 62 and 83, Guedalia teaches a method/system of requesting protected

digital image data from the remote computer, using the address for the remote computer and the

file name for the protected digital image; and receiving protected digital image data from the

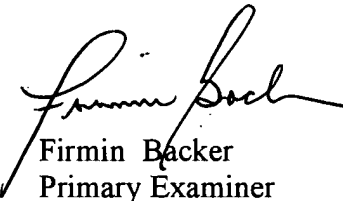remote computer (*see column 12 lime 15-58*).

25.   As per claims 63-65 and 84-86, Guedalia teaches a method/system wherein the substitute

data is pre-defined image/watermarked data derived from the digital images and is encrypted

data derived from the digital images using an encryption algorithm (*see column abstract, column

1 lines 19-30, 3 line 65-4 lines 41, 6 lines 4-36, claim 1*).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The

examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Firmin Backer
Primary Examiner
Art Unit 3621

March 31, 2005